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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,038	02/27/2002	James R. Komorowski	NUTRI.023A	6775
20995	7590	03/25/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			CHOI, FRANK I	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,038

Applicant(s)

KOMOROWSKI ET AL.

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2003 has been entered.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4-6,8,10-13,17,19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rath (US Pat. 6,693,129).

Rath expressly discloses a method of treating high LDL and high triglycerides by administering a composition containing biotin and chromium glycinate falling within the scope of applicant's claims (Column 6, lines 34-68, Column 7, Column 8, lines 1-20).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978). See also *Ex parte Novitski*, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993).

Claims 1-20, 23-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *McCarty* (US Pat. 5,789,401) or *McCarty* (US Pat. 5,929,066), each in view of *de la Harpe et al.* (US Pat. 5,948,772) and *Brand-Miller* for the reasons of record set forth in the prior Office Actions and in further view of *Rath* (US Pat. 6,693,129) and the further reasons below.

McCarty (US Pat. 5,789,401) or *McCarty* (US Pat. 5,929,066) were discussed in the prior Office Actions and the same are incorporated herein.

de la Harpe et al., *Jensen* and *Brand-Miller* were discussed in the prior Office Actions and the same are incorporated herein.

Rath discloses a composition containing biotin and chromium glycinate which is effective in lowering LDL and triglycerides which can be administered orally or parenterally, and that those skilled in that art would understand that changes can be made and equivalents substituted and that effective amounts may vary depending on variations in patients, durations of treatment, etc. and that modifications may made to adapt a particular situation and composition of matter (Column 5, lines 45-56, Column 6, lines 36-68, Column 7, Column 9, lines 1-33)

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

Art Unit: 1616

combinations of references. See *In re Keller*, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981).

Applicant argues that the disclosure in de la Harpe et al. does not relate to diabetics. However, de la Harpe clearly discloses that hypercholesterolemia is present in diabetics. (De La Harpe, Column 1, lines 24-36). Diabetics suffer from ineffective insulin and compromised glucose metabolism, as such, one of ordinary skill in the art would expect that since ineffective insulin and compromised glucose metabolism leads to hypercholesterolemia that biotin which is known to be effective in making insulin more effective would also alleviate hypercholesterolemia. Further, there is no requirement that the prior art treat all forms of dyslipidemia as long as it would be expected to be effective in treating hypercholesterolemia which results from ineffective insulin and compromised glucose metabolism the prior art reads on the claimed invention.

Applicant argues that McCarty references do not disclose that biotin supplementation has any effect on the lipid profile of normal or diabetic individuals. However, as indicated above, the rejection is based on a combination of references not McCarty alone. Further, there is no requirement as indicated above that the claimed invention must be expressly suggested in any one or all of the references. Also, Rath discloses a composition containing biotin which is effective in lowering LDL and triglycerides.

Applicant amends the claims by adding the limitation "synergistically" and cites to Figures 2 and 14 and pages 15 and 25 of the Specification for supported of this synergistic effect. However, the evidence of synergy is not commensurate in scope with the breath of the claims as only specific amounts are tested and only glucose uptake and HDL-change are shown. Whereas the claims broadly claim a synergistically effective dose and/or do not indicate the synergistic effect. Even assuming the evidence of synergy is commensurate in scope with the claims, both McCarty '066 and McCarty '401 disclose the combination of biotin and chromium complex results in synergistic effects (McCarty '066, Column 2, lines 56-65; McCarty '401, Column 2, lines 49-57). As such, the evidence does not appear to show anything which would be unexpected.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion


A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telcopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Thurman Page, can be reached at (571)272-0602. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

March 21, 2004



JOHN PAK
PRIMARY EXAMINER
GROUP 1600